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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/842,219

04/26/2001

Shunpei Yamazaki

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11/28/2006

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EXAMINER

HENNING, MATTHEW T

ART UNIT

PAPER NUMBER

2131

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/842,219

Applicant(s)

YAMAZAKI ET AL.

Examiner

Matthew T. Henning

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,26,51 and 54-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,26,51 and 54-83 is/are rejected.
- 7) ☒ Claim(s) 83 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/21/06 9/11/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1 This action is in response to the communication filed on 9/11/2006.

2 **DETAILED ACTION**

3 *Continued Examination Under 37 CFR 1.114*

4 A request for continued examination under 37 CFR 1.114, including the fee set forth in
5 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is
6 eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)
7 has been timely paid, the finality of the previous Office action has been withdrawn pursuant to
8 37 CFR 1.114. Applicant's submission filed on 9/11/2006 has been entered.

9 *Response to Arguments*

10 Applicant's arguments filed 9/11/2006 have been fully considered but they are not
11 persuasive.

12 Applicant argues primarily that Li did not disclose the server transmitting the information
13 that the read biological information and the stored biological information have matched to a final
14 end of transaction. The examiner points out that although Li did not explicitly disclose sending
15 such information, it can be seen in Figs. 3A and 3B that the CAS (server) of Li sends the identity
16 of the caller to the recipient, and that this is only sent in the case that there was a match. As
17 such, the mere act of sending the identity carries with it the "information" that a match was
18 made. Furthermore, if a match was not made, the server would not know the identity to be able
19 to send the identity. This interpretation of the claim language is consistent with the disclosure of
20 the instant application on page 13, which the applicants rely upon as supporting the newly added
21 limitation, wherein there is no disclosure of "identical data" being transmitted from both the

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1 client to the server and then from the server to the final end, but rather the “information”
2 indicating that there was a match is of a contextual nature.

3 Furthermore, the examiner points again to Fig. 3B in that the connection is not “started”
4 until after the “caller identity” is sent to the recipient, at which point the recipient decides
5 whether to establish the connection or not, as seen in Col. 16 Paragraph 2 of Li.

6 As such, the examiner does not find the argument persuasive and has maintained the prior
7 art rejections in view of Li.

8 Claims 1, 26, 51, and 54-83 have been examined. Claims 2-25, 27-50, and 52-53 have
9 been cancelled.

10 All objections and rejections not set forth below have been withdrawn.

11 *Claim Objections*

12 Claim 83 is objected under 37 C.F.R. 1.75(d) as being indefinite for failing to particularly
13 point out and distinctly claim the subject matter which applicant regards as the invention.

14 Claim 83 recites the limitation “said information” in the last line of the claim. There is
15 multiple antecedent basis for this limitation in the claim. One of ordinary skill in the art would
16 be unable to determine whether “said information” is referring to “the read biological
17 information”, “the reference biological information”, or “the information that the read biological
18 information and the reference biological information have matched”. As such the scope of the
19 claim is not ascertainable. For the purposes of searching prior art, and to remain consistent with
20 the other independent claims, the examiner will assume that “said information” was referring to
21 “the information that the read biological information and the reference biological information
22 have matched”.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 26, 51, 54-60, and 62-82 are rejected under 35 U.S.C. 102(e) as being anticipated by Li et al. (US Patent Number 6,219,793) hereinafter referred to as Li.

Regarding claims 1 and 26, Li disclosed a system for identifying a client (See Li Abstract), the system comprising a server and a portable communication device comprising: a memory for storing at least one reference biological information of the client using the portable communication device (See Li Fig. 4 Element 404, Col. 10 Lines 57-65 and Col. 12 Lines 20-27); a sensor for reading at least one biological information of the client (See Li Fig. 4 Element 417); a checking circuit for checking the read biological information with the stored biological information (See Li Fig. 4 Element 401 and Col. 12 Lines 8-36); and a transmitting circuit for transmitting information that the read biological information and the stored biological information have matched to the server in a case where the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9), wherein the server is configured to transmit the information that the read biological information and the stored biological information have matched to a final end of transaction configured to start a transaction with the client conditioned

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1 upon receipt of the information that the read biological information and the stored biological
2 information have matched (See Li Col. 16 Paragraph 2).

3 Regarding claim 51, Li disclosed a business method using the Internet, said business
4 method comprising: identifying a client by an identifying element loaded in a portable
5 communication device (See Li Fig. 1 Elements 101, 102, and 112 and Fig. 4); and controlling a
6 communication between the client and a plurality of dealers (See Li Fig. 2 Element 202) by a
7 control element in a server (See Li Abstract, and Figs. 3A and 3B); wherein said identifying
8 comprises: storing a reference biological information of the client in the portable communication
9 device (See Li Fig. 4 Element 404 and Col. 10 Lines 57-65 and Col. 12 Lines 20-27); reading
10 biological information of the client (See Li Col. 10 Lines 57-58); checking the read biological
11 information with the reference biological information (See Li Col. 10 Lines 61-65); and
12 transmitting information that the read biological information and the reference biological
13 information have matched from the identifying element to the control element in a case where
14 the checking has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9), and
15 wherein said controlling step comprises: admitting the communication between the client and the
16 plurality of dealers after identifying the client by the identifying element (See Li Col. 11 Lines
17 19-60); and providing a password to the client (See Li Col. 10 Lines 48-56), and wherein the
18 server is configured to transmit the information that the read biological information and the
19 stored biological information have matched to a final end of transaction configured to start a
20 transaction with the client conditioned upon receipt of the information that the read biological
21 information and the stored biological information have matched (See Li Col. 16 Paragraph 2).

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1 Regarding claim 83, Li disclosed a system for identifying a client, said system
2 comprising: a server (See Li Fig. 1 Element 106); a storing means for storing reference
3 biological information of the client (See Li Fig. 4 Element 404); a reading means for reading
4 biological information of the client (See Li Fig. 4 Element 101); a checking means for checking
5 the read biological information with the reference biological information (See Li Col. 10 Lines
6 61-65); a transmitting means for transmitting information that the read biological information
7 and the reference biological information have matched to the server in a case where the checking
8 has matched (See Li Fig. 4 Elements 402 and 102 and Col. 11 Lines 3-9); a final end of
9 transaction (See Li Fig. 3B Step 319 Recipient and Col. 16 Paragraph 2); a further transmitting
10 means for transmitting said information that the read biological information and the reference
11 biological information have matched from the server to the final end of transaction with the
12 client (See Li Fig. 3B Step 319 and Col. 16 Paragraph 2); and a transaction starting means for
13 starting a transaction between the client and the final end of transaction after the final end of
14 transaction has received said information (See Li Fig. 3B Steps 316 and 319 and Col. 16
15 Paragraph 2).

16 Regarding claims 54 and 66, Li disclosed that the memory stores a plurality of biological
17 information of the client (See Li Col. 15 Paragraph 3 and Col. 3 Paragraph 3 and Col. 10
18 Paragraph 4), and the transmitting circuit transmits information that the read biological
19 information has matched with at least one of the stored plurality of information to the server (See
20 Li Col. 11 Lines 3-9).

21 Regarding claims 55 and 67, Li disclosed that the sensor reads a plurality of biological
22 information of the client (See Li Col. 15 Paragraph 4), and the transmitting circuit transmits

1 information that each of the plurality of read biological information has matched with at least
2 one of the plurality of stored biological information (See Li Col. 11 Lines 3-9).

3 Regarding claims 56 and 68, Li disclosed that the information that the read biological
4 information and the stored biological information have matched is transmitted to the server
5 through the Internet (See Li Col. 7 Paragraph 2).

6 Regarding claims 57 and 71, Li disclosed that after transmitting information that the
7 checking has matched to the server, a personal identification number information is sent to the
8 Server (See Li Col. 15 Paragraphs 3-4).

9 Regarding claims 58 and 72, Li disclosed that in a case that the personal identification
10 number matches with a number stored at the server, the stored biological information is
11 rewritable (See Li Col. 15 Paragraph 3).

12 Regarding claims 59-60, 73-74, and 78-79, Li disclosed that the biological information is
13 one selected from the group consisting of a fingerprint, a palm pattern and a voice print; and that
14 the palm pattern is a whole pattern of the palm or a pattern of a part of the palm (See Li Col. 6
15 Paragraph 3 and Col. 17 Paragraph 3).

16 Regarding claim 62, Li disclosed that the sensor includes one of a photodiode and a CCD
17 (See Li Col. 4 Paragraph 6).

18 Regarding claims 63-65, 75-77, and 80-82, Li disclosed that the portable communication
19 device comprises a portable information terminal; a portable telephone; a personal computer (See
20 Li Col. 5 Line 66 – Col. 6 Line 14).

21 Regarding claims 69-70, Li disclosed a step of transmitting information that the checking
22 has matched from the server to a connection of the client; and that a transaction is started

1 between the client and the connection after the connection has received information that the
2 checking has matched (See Li Col. 16 Paragraph 2).

3 ***Claim Rejections - 35 USC § 103***

4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all
5 obviousness rejections set forth in this Office action:

6 A patent may not be obtained though the invention is not identically disclosed or described as set forth in section
7 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the
8 subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in
9 the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was
10 made.

11
12 Claim 61 is rejected under 35 U.S.C. 103(a) as being unpatentable over Li as applied to
13 claim 1 above, and further in view of Osborn (US Patent Number 6,026,293).

14 Li disclosed a memory unit containing programs, responses and any other information the
15 Fingerprint Capturing Module of the cellular phone needed to operate (See Li Col. 12 Lines 20-
16 27), but failed to disclose what type of memory the memory unit was.

17 Osborn teaches that in cellular telephones, programs are stored in flash memory (See
18 Osborn Col. 3 Line 61 – Col. 4 Line 2).

19 It would have been obvious to the ordinary person skilled in the art at the time of
20 invention to employ the teachings of Osborn in the authenticating cellular telephone of Li by
21 providing the memory unit as a flash memory. This would have been obvious because the
22 ordinary person skilled in the art would have been motivated to store the programs of the phone
23 in the conventional manner.

24 ***Conclusion***

25 Claims 1, 26, 51, and 54-83 have been rejected.

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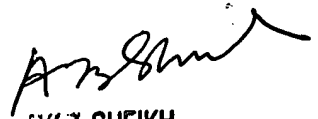
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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11/16/2006



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